

REMARKS

Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 are currently pending in the subject application and are presently under consideration.

The Examiner is thanked for courtesies extended during an interview conducted on June 11, 2008. The main focus of the interview was on deficiencies of the 35 U.S.C. §103(a). While the presented matter generally related to all the claims, the crux was upon claims 1 and 12. Additionally, applicants' representative stated that verbal and written arguments (e.g., disclosed herein) regarding claims 1 regarding the file preview operation also applies to claims 13 and 27. In particular, Moran and Saund references were discussed. No agreements were reached. The interview was conducted with Ronald Krosky (Reg. No. 58,564) and Examiner Rutledge. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 Under 35 U.S.C. §103(a)

Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moran (US Patent 6,509,912) in view of Saund (US Patent 6,411,732).

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) citing *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1, 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (*quoting Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))).

Claim 1 recites “A computer system, comprising: an input system that receives a file save command; a rendering system for rendering a file save interface in response to the input system receiving the file save command, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the file save interface; a storage system that stores the property value of the document or file in electronic ink format; and an ink access system that allows the operating system to access the stored property value in electronic ink format, *wherein the rendering system renders the stored*

property value in electronic ink format as part of a file preview operation, and wherein the property value in electronic ink format includes an electronic ink filename for the document or file.” (emphasis added).

Moran discloses generating domain objects regarding freeform objects. Moran does not disclose rendering the stored property value as part of a file preview operation as is recited in claim 1. Applicants’ representative respectfully contends that the examiner erroneously states Moran discloses the aforementioned aspect in col. 13, ln. 20-29. The portion cited by the Examiner relates to a gesture (double-tapping) upon an icon that expands information. However, in the cited portion, ‘to expand’ is used in a context of making larger or smaller. Moran discloses **“To expand the information about a domain object**, double-tap on the icon. **This will result in another layout of the domain object being displayed as an overlay. Sometime it is useful to expand an icon to a somewhat larger version by replacing the original icon** (not as an overlay). This is invoked by a right gesture (and a left gesture is used to replace the larger icon by a smaller one).” (emphasis added). Thus there are two expansions discussed. First, an expansion is discussed by using displaying a second overlay over a first. Secondly, a replacement occurs as opposed to using an overlay. What is discussed in Moran would not be considered a preview since information does not change. In Moran, expansion is a physical expansion such that a smaller version is disclosed. However, information is the same in an original icon against a displayed icon and thus a preview is not occurring. The Examiner contends that this is a file preview (response page 3, ln. 7-11), however, the object being an overlay relates to size of the icon and not previewing information. A thorough review of portions of Moran not cited by the Examiner also do not disclose rendering the information as part of the file preview.

MPEP 706.02(j) states “It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” Nowhere does the Examiner state in the Office Action which reference discloses “an input system that receives a file save command” as recited in claim 1 and similarly in claims 13 and 27. Additionally, MPEP 2142 states “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Without disclosing how the Examiner believes either of the cited references disclose an input component as recited in claim 1 (and similarly in claims 13 and 27), then there is not clear articulation of the reason why the claimed invention should have been obvious.

Additionally, claim 12 (dependent upon claim 1) recites “A computer system according to claim 1, wherein *the property value* in electronic ink format includes *an electronic ink author identification.*” (emphasis added). Claims 26 and 40 recites a similar limitation. Neither reference discloses using author identification in reference to the property value. The Examiner contends that use of a label teaches author identification. However, user of the term label in the Moran reference is ambiguous and it is unclear how the label would disclose author identification. Moran states “Label. *Represents a label* that can be placed near another object *to tag them.*” (emphasis added) (col. 14, ln. 5-6). More discussion of labels is made in col. 21, ln. 52-60 of Moran. Claim 11 does not recite tagging an object, but placing author identification information that is not disclosed by either cited reference, not only in portions cited by the Examiner, but in the reference in their entirety.

Therefore, for at least the aforementioned reasons, the rejections of claim 1, 13, and 27 (and dependent claims therein) should be removed and the claims placed into a condition of allowance.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP2336USUS].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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